

REMARKS

Claims 9-20 are pending. By this Amendment After Final, claims 11 and 15 are canceled, and claims 9, 10, 14 and 16 are amended. After entry of this Amendment After Final, claims 9, 10, 12-14 and 16-20 will remain pending in the present application.

Entry of this Amendment After Final is respectfully requested, as it is believed to put the claims in condition for allowance. The claim amendments do not add matter which would necessitate an additional search.

Objection to the Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) indicating that the drawings did not depict a pair of grappler arms. As noted above, claim 15, which referred to “a pair of grappler arms,” has been canceled.

Cancellation of claim 15 is believed to obviate this objection. Reconsideration and withdrawal of the objection to the drawings is respectfully requested.

Rejections under 35 U.S.C. § 112

The Examiner rejected claims 10-12 under 35 U.S.C. § 112, first paragraph, indicating that the specification did not support the use of “said forearm comprises a grappler or an excavator bucket, said excavator bucket interchangeable with said grappler,” in claims 11 and 12.

Claim 10 has been amended to indicate that the forearm comprises a grappler and an excavator bucket. Use of these terms is supported in Figures 1 and 2 and the corresponding description in the present application.

Without prejudice, claim 11 has been canceled.

With respect to claim 12, support for the use of the phrase “hydraulically operated backhoe forearm” is found in Paragraphs [0024], [0025], [0032]-[0036] and the accompanying illustrations in Figures 1 and 2. Based upon the preceding items, the structure and function of the hydraulically operated backhoe forearm is sufficiently disclosed in the patent application as filed such that the use of these limitations in Claim 12 does not constitute new matter.

In light of the preceding comments and the related claim amendments, it is submitted that each of the rejections under Section 112, first paragraph, are overcome. Reconsideration and withdrawal of the rejections under Section 112, first paragraph, are respectfully requested.

The Examiner rejected claims 10-12 and 15 under 35 U.S.C. § 112, second paragraph. As discussed above, claim 10 has been amended to specify that that forearm comprises a grappler and an excavator bucket.

Without prejudice, claim 11 has been canceled.

As illustrated in the Figures and described in the accompanying text, the stabilizing arm comprises the hydraulically operated backhoe forearm. While it is not required for the stabilizing arm additional functionality beyond stabilizing the machine, adding hydraulically operated backhoe functionality to the stabilizer arm increases the tasks that can be performed by the machine.

Without prejudice, claim 15 has been canceled.

In light of the preceding comments and the related claim amendments, it is submitted that each of the rejections under Section 112, second paragraph, are overcome. Reconsideration and withdrawal of the rejections under Section 112, second paragraph, are respectfully requested.

### **Rejections under 35 U.S.C. § 103**

The Examiner rejected claims 9-13 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Gravenhorst, US Patent No. 5,048,172, in view of Salna, US Patent No. 2,876,921.

Without providing any explanation, the Examiner cited Fig. 10 of Gravenhorst for disclosing a stabilizing arm. The Examiner cited Salna for disclosing the use of a solenoid valve to operate a loader with a bucket. The Examiner then contended that it would have been obvious to combine the references to produce the claimed invention.

To establish a *prima facie* case of obviousness, a rejection must cite documents which teach or suggest all the claim limitations,<sup>1</sup> establish a proper motivation for modifying the documents cited against the claims,<sup>2</sup> and show a reasonable expectation

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<sup>1</sup> See M.P.E.P. 2143 (“To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”).

<sup>2</sup> See M.P.E.P. § 2142 (“To establish a *prima facie* case of obviousness, ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings .... The teaching or suggestion to make the claimed combination ... must ... be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).”).

of success.<sup>3</sup> The motivation to modify the documents cited against the claims must be present in the documents themselves, not in the instant application.<sup>4</sup>

Neither conclusory statements within the rejection nor subjective opinion stated in the rejection are sufficient to establish the required motivation to modify the documents cited against the claims.<sup>56</sup> If the rejection asserts that the motivation was generally present in the art at the time of the invention, the Examiner may be required to execute an affidavit or declaration to that effect so that the Applicant may have the opportunity to explain or dispute the assertions therein.<sup>7</sup> Additionally, evidence of

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<sup>3</sup> See M.P.E.P. § 2143 (“To establish a prima facie ease of obviousness, ... there must be a reasonable expectation of success. The ... reasonable expectation of success must ... be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

<sup>4</sup> See M.P.E.P. § 2142 (“The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.”).

<sup>5</sup> See, In re Lee, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002) (“This factual question of motivation is material to patentability and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983). Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.”) (emphasis added).

<sup>6</sup> In re Lee, 61 U.S.P.Q.2d 1430, 1434 (Fed Cir. 2002) (“The examiner's conclusory statements that the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software and that another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to [use] that which the inventor taught against its teacher. W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983). Thus, the Board must not only assure that the requisite findings are made based on evidence of record but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.”) (internal quotation marks omitted) (emphasis added).

<sup>7</sup> See M.P.E.P. § 2144.03 (“As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. In re Zurko, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001).... If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 C.F.R. 1.104(d)(2) [‘When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported when called for by the applicant by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons’].”) (emphasis added).

patentability is established if the disclosures of the cited documents actually teach away from the asserted modification.<sup>8</sup>

While acknowledging that Renfro arguably discloses a body, a boom, a winch pulley, a winch reel and a bucket, the Examiner has provided no explanation of what aspect of the Renfro device is a stabilizing arm.

Independent claim 9 has been amended to more clearly define that the stabilizing arm is attached to the boom and the stabilizing arm stabilizes the machine when said logs are being retrieved.

In Paragraph 69 of the present application, it is indicated that the machine has “an appendage backhoe ‘fore-arm’ (11) fitted under the backhoe bottom arm portion to support the boom, providing leverage and stability to the excavator in the process of winching, therefore enabling greater efficiency and overall productivity of the machine and logging operation as a whole, which has not been able to be attained by other methods previously known.” (emphasis added)

The only components of the Gravenhorst device that contact the ground are the tracks (103). Gravenhorst does not teach or suggest any component that extends from the boom (400), which stabilizes the device when moving objects.

Neither Gravenhorst nor Salna appreciate when viewed separately or together that the ability of the logging device to drag logs across a ground surface can be enhanced by using a stabilizing arm that extends from the boom. Accordingly, claim 9 and claims 10-13, which depend from claim 9, are not obvious when viewed in light of

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<sup>8</sup> See MPEP § 2155.05 (“A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In re Geisler, 116 F.3d 1465, 1471, 43 U.S.P.Q.2d 1362, 1366 (Fed. Cir. 1997)”).

Gravenhorst and Salna. Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner rejected claims 9, 11 and 15-20 under 35 U.S.C. § 103(a) as being unpatentable over Renfro, US Patent No. 4,917,567, in view of Salna. The Examiner indicated that Renfro discloses “a body (fig. 1), a boom (fig. 1), a winch pulley (fig. 1), a winch reel (fig. 1), a stabilizing arm (fig. 1) and a bucket (66). The Examiner cited Salna for disclosing the use of a solenoid valve to operate a loader with a bucket.

While acknowledging that Renfro arguably discloses a body, a boom, a winch pulley, a winch reel and a bucket, the Examiner provided no explanation of what aspect of the Renfro device is a stabilizing arm.

Independent claim 9 has been amended to more clearly define that the stabilizing arm is attached to the boom and the stabilizing arm stabilizes the machine when said logs are being retrieved.

In Paragraph 69 of the present application, it is indicated that the machine has “an appendage backhoe ‘fore-arm’ (11) fitted under the backhoe bottom arm portion to support the boom, providing leverage and stability to the excavator in the process of winching, therefore enabling greater efficiency and overall productivity of the machine and logging operation as a whole, which has not been able to be attained by other methods previously known.” (emphasis added)

The only components of the Renfro device that contact the ground are the tracks (5). Renfro does not teach or suggest any component that extends from the boom (20), which stabilizes the device when winching logs.

Neither Renfro nor Salna appreciate that the ability of the device to drag logs across a ground surface can be enhanced by using a stabilizing arm that extends from the boom. Accordingly, claim 9 and claim 11, which depends from claim 9, are not obvious when viewed in light of Renfro and Salna. Reconsideration and withdrawal of this rejection are respectfully requested.

Similarly, claim 16 has been amended to more clearly define the function of the stabilizing arm as including “moving said stabilizing arm so that a distal end of said stabilizing arm engages a ground surface adjacent said log retrieving machine.”

Neither Renfro nor Salna teach or suggest a logging device that includes this capability. Accordingly, claim 16 and claims 17-20, which depend from claim 16, are nonobvious when viewed in light of these references. Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Gravenhorst in view of Salna and Renfro. Claim 14 depends from claim 9. As discussed above, claim 9 is not obvious when viewed in light of Gravenhorst, Renfro and Salna when viewed individually or together.

Since claim 14 depends from claim 9, claim 14 is also non-obvious when viewed in light of the combination of Gravenhorst, Salna and Renfro. Reconsideration and withdrawal of the rejection of claim 14 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Very truly yours,



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